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TOWNSEND and TOWNSEND and CREW LLP

By: Kay Barclay
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PATENT
Attorney Docket No.: 020366-074300US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Arnold M. Lund, et al.

Application No.: 09/596,973

Filed: June 20, 2002

For: SHARING FUNCTIONS BETWEEN A TELEVISION-BASED INFORMATION APPLIANCE AND REMOTE CONTROL DEVICES

Customer No.: 20350

Confirmation No. 6256

Examiner: John Manning

Technology Center/Art Unit: 2614

SUPPLEMENTAL APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants offer this Corrected Supplemental Appeal Brief in support of the Request to Maintain Appeal under 37 CFR §41.39(b)(2), or alternatively, for Reinstatement of Appeal under MPEP §1208.02-03.

1. Real Parties in Interest

Qwest Communications International Corporation is the real party in interest as the assignee of the above-identified application.

2. Related Appeals and Interferences

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. Status of Claims

Claims 1-10, 21-26, and 33 are currently pending in the application. All pending claims stand finally rejected pursuant to a Final Office Action mailed June 29, 2005. The Office reopened prosecution after Appellants filed a Notice of Appeal on November 29, 2004, and filed a Brief in Support thereof January 31, 2005. The rejections of claims 1-10, 21-26, and 33 are believed to be improper and are the subject of this appeal.

4. Status of Amendments

No amendments have been filed subsequent to the Final Office Action.

5. Summary of Claimed Subject Matter

In the following summary, Appellants have provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be illustrative in nature only.

Methods and systems are disclosed which allow a user to select where caller identification information is to be displayed. In the embodiment of claim 1, an information system is disclosed which comprises a display and a video source sending video to be displayed on the display 12. Application, p. 3, ll. 5-14; Figure 1, ref. 14, 12. A remote generates a wireless

signal for controlling the video source. Id., p. 4, ll. 8-9, p. 5, ll. 14-15; Figure 1, ref. 18, 30. The remote includes a caller identification display for displaying caller identification information and at least one of a microphone or a speaker for telephone communication. Id., p. 5, l. 18 - p. 6, l. 2; Figure 3. The information system also comprises a menu to be displayed on the display. Id., Figure 5. The menu includes a plurality of options for a user to select one or more locations to display caller identification information. Id., p. 7, ll. 9-15. One of the options comprises displaying the caller identification information on the remote. Id.

In the embodiment of independent claim 21, a method for operating an information system including a display and a remote includes displaying video on the display. Id., p. 7, ll. 16-17. An option is provided to display caller identification information on the display. Id., p. 7, ll. 9-15. A second option is also provided to display caller identification information on the remote. Id. A user selection to display the caller identification information on a selected one of the display or the remote is received. Id., p. 7, ll. 19-20. The method also includes determining that a telephone call is incoming to the information system. Id., p. 7, ll. 20-21. Caller identification information is received from the incoming call and the caller identification information is displayed on the selected one of the display or the remote. Id.

In the embodiment of claim 33, a remote input device for an information system is disclosed comprising at least one user input device, a transmitter, a receiver, and a display. Id., p. 3, ll. 13-15; p. 5, ll. 19-20; Figure 3. The transmitter generates a wireless signal for controlling an information system component based upon activation of the user input device. Id., p. 3, ll. 13-18. The receiver receives a wireless signal including caller identification information received from a telephone system. Id., p. 3, ll. 13-15; p. 5, ll. 18-20. The display displays caller identification information received via the transceiver based on a user option configuring the display location of the caller identification information. Id., p. 7, l. 18 - p. 8, l. 4.

6. Grounds of Rejection Presented for Review

A. Claims 1, 3-10, 21-26, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,671,267 to August et al. (hereinafter "August") in view of U.S. Patent No. 6,567,984 to Allport et al. (hereinafter "Allport").

B. Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over August in view of U.S. Patent No. 6,292,172 to Makhlouf (hereinafter "Makhlouf").

7. Argument

A. Whether claims 1, 3-10, 21-26, and 33 are obvious over August in view of Allport.

Claims 1, 3-10, 21-26, and 33 stand rejected under 35 U.S.C. § 103(a) as being obvious over August in view of Allport. For this rejection to be proper, the cited references must teach or suggest all of the recitations of these claims. Appellants respectfully submit that these claims are patentable as the rejection fails to meet this burden.

Claims 1, 3-10

Claim 1 recites an information system comprising a display, a remote, and a menu to be displayed on the display. The menu includes a plurality of options for a user to select one or more locations to display caller identification information. One of the options comprises displaying caller identification information on the remote. Neither August, nor Allport, disclose a menu with options as recited in claim 1.

August discloses a handset unit which provides normal wireless communications with a cordless telephone base unit. August, col. 1, ll. 29-31. The handset unit also provides two-way remote control functions for interacting with devices, such as a video receiving device or set-top box. Id., col. 1, ll. 31-39. While a telephone is ringing, the number of a calling party may be displayed on the video receiving device and/or the display of the handset unit. Id., col. 10, ll. 29-33. There is *no teaching or suggestion* that the location of the calling number is a *user-selectable option*. Additionally, as acknowledged by the Examiner, August fails to disclose a menu which includes options for the user to select location(s) to display caller identification information.

Allport also fails to teach a menu with options for a user to select location(s) to display caller identification information. In Allport, a system is disclosed whereby different data streams may be viewed simultaneously, each stream viewed though a different device. Allport, abstract, ll. 1-8. Allport is directed at the problems associated with PIP, wherein "a primary

program may be playing on the entire physical TV display while a secondary program (the PIP) is playing in a small area in the corner of the display. The primary program is degraded due to the screen real estate used up by the secondary program, and the secondary program is degraded because it is not able to occupy the full size of the physical display." Id., col. 3, ll. 8-15. Allport also discloses a remote control with buttons that "could be used for changing font sizes of any text data, scrolling through text, or swapping the *programs* showed on the two displays." emphasis added, Id., col. 8, ll. 2-5.

There is no teaching or suggestion that the Allport invention be integrated into a traditional phone system, or used to provide caller identification information. Thus, there is *no* teaching or suggestion that the display or *location* of a calling number is a *user-selectable option*. The Office points out how the system "software is preferably programmable by the user." Id., col. 8, l. 53 -col. 9, l. 10. However, these generalized passing references in Allport clearly fail to teach or suggest a *menu* with a *plurality of options* for a user to select *location(s)* to display *caller identification information*.

The cited references provide *no teaching or suggestion* that the location of the calling number is a *user-selectable option*, or that such options may be selected from a *menu*, and therefore they fail to teach or suggest the recitations of claim 1 discussed above. Thus, the rejection of claim 1 under 35 U.S.C. § 103(a) is improper. Claims 3-10 depend from claim 1. The rejections of these claims are also believed to be improper for at least the same reasons as claim 1. Therefore, Appellants respectfully request the rejections to claims 1 and 3-10 be reversed.

Claim 21-25

Claim 21 recites a method for operating an information system including a display and a remote. The method includes "providing an option to display caller identification information on the display" and "providing a second option to display caller identification information on the remote." As discussed with reference to claim 1, August and Allport both fail to teach or suggest providing an option to display caller identification information on a remote or an option to display caller identification information on a display. Accordingly, both references

also fail to teach or suggest the additional recitation of claim 21 of "receiving a user selection to display the caller identification information on a selected one of the display or the remote."

As the cited references fail to teach or suggest all of the recitations of claim 21, claim 21 is patentable. Appellants also submit that claims 22-25, which depend from claim 21, are also patentable for at least the same reasons. Hence, Appellants respectfully request the rejections to claims 21-25 be reversed.

Claim 26

The rejection of claim 26 is believed to be improper for at least the same reasons as parent claim 21. Furthermore, the rejection of claim 26 is also believed to be improper as the cited reference fails to teach or suggest the additional recitations of this claim. The method, as recited by claim 26, further comprises providing an option to provide communication via the audio transceiver on the remote or an audio transceiver on the display. Claim 26 also recites receiving a selection of one of the remote or display in response to said providing the option. Neither reference teaches or suggests receiving a selection to provide communication on the remote or the display.

The Examiner has attempted to interpret this claim so that the recitation of receiving a selection is inherent. Final Office Action, June 29, 2005, p. 9-10. However, Appellants respectfully submit that the Examiner's interpretation is unreasonable. Claim 26 positively recites that the method includes receiving a selection to provide communication via one of the audio transceiver on the remote or the audio transceiver on the display. Neither reference discloses receiving such a selection. Accordingly, Appellants respectfully request the rejection to claim 26 be reversed.

Claim 33

Claim 33 stands rejected under 35 U.S.C. § 103(a) as being obvious over August in view of Allport. Appellants respectfully submit the rejection of claim 33 is improper as the cited references fail to teach or suggest all of the recitations of this claim.
Claim 33 recites a remote input device comprising a display. The display displays caller identification information based on a user option configuring the display location of caller

identification information. As previously discussed with respect to claim 1, August and Allport fail to teach or suggest a user option for configuring the display location of caller identification information. Hence, August and Allport also fail to teach or suggest a remote input device which displays caller identification information based on such an option.

B. Whether claim 2 is obvious over August in view of Makhlouf.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being obvious over August in view of Makhlouf. Claim 2 depends from claim 1. As previously discussed, August fails to teach or suggest the recitations of claim 1 of a menu including options for a user to select location(s) to display caller identification information. Makhlouf also fails to teach or suggest these recitations. In fact, Appellants can find no teaching or suggestion in Makhlouf of any type of menu with user-selectable options. As acknowledged by the Examiner, August also fails to disclose a menu with user options. Hence, Appellants submit the rejection of claim 2 is improper.

Conclusion

Appellants believe that the above discussion is fully responsive to all grounds of rejection set forth in the application. It is believed that no fee is required for filing the Request for Reinstatement of Appeal or this Supplemental Appellant Brief. Should the Patent Office determine otherwise, however, please deduct the requisite fee from Deposit Account 20-1430.

Respectfully submitted,

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8. APPENDIX

The claims pending in the application are as follows:

1. (Previously Presented) An information system comprising:

a display;

a video source sending video to be displayed on the display;

a remote generating a wireless signal for controlling the video source, the remote including a caller identification display for displaying caller identification information and at least one of a microphone and a speaker for telephone communication;

a menu to be displayed on the display, the menu including a plurality of options for a user to select one or more locations to display caller identification information, one of the options comprising displaying the caller identification information on the remote.

2. (Original) The information system of claim 1 wherein the remote is a wireless keyboard.

3. (Original) The information system of claim I wherein the remote selectively generates a wireless signal for changing the video to the display.

4. (Original) The information system of claim 1 wherein the remote includes the microphone and the speaker.

5. (Original) The information system of claim 1 further including a telephone base unit in wireless communication with the remote.

6. (Original) The information system of claim 5 wherein the telephone base unit is in communication with a telephone network.

7. (Original) The information system of claim 1 wherein the video source is a subscription television decoder.

8. (Original) The information system of claim 1 wherein the video source is a main unit providing video and telephone communication.

9. (Original) The information system of claim 8 wherein the main unit includes a subscription television decoder.

10. (Original) The information system of claim 9 wherein the main unit includes an internet connection.

11. (Canceled)

12. (Canceled)

13. (Canceled)

14. (Canceled)

15. (Canceled)

16. (Canceled)

17. (Canceled)

18. (Canceled)

19. (Canceled)

20. (Canceled)

21. (Previously Presented) A method for operating an information system including a display and a remote, the method including the steps of:

a) displaying video on the display;

b) providing an option to display caller identification information on the display and providing a second option to display caller identification information on the remote;

c) receiving a user selection to display the caller identification information on a selected one of the display or the remote;

d) determining that a telephone call is incoming to the information system;

e) receiving caller identification information from the incoming call; and

f) displaying the caller identification information on the selected one of the display or the remote.

22. (Original) The method of claim 21 further including the step of transmitting the caller identification information to the remote prior to said step f).

23. (Original) The method of claim 22 wherein said step f) further includes the step of displaying the caller identification information on the remote.

24. (Original) The method of claim 21 further including the step of controlling the video on the display by sending a wireless signal from the remote.

25. (Previously Presented) The method of claim 21, further comprising:

a) changing the video on the display with a wireless remote; and

b) communicating on the telephone call via an audio transducer on the remote.

26. (Previously Presented) The method of claim 25 further including the steps of:

a) providing an option to provide communication via the audio transceiver on the remote or an audio transceiver on the display; and

b) receiving a selection of one of the remote or display in response to said providing the option; and

c) communicating on the telephone call via the selected one of the audio transceiver on the display or the remote.

27. (Canceled)

28. (Canceled)

29. (Canceled)

30. (Canceled)

31. (Canceled)

32. (Canceled)

33. (Previously Presented) A remote input device for an information system comprising:

at least one user input device;

a transmitter for generating a wireless signal for controlling an information system component based upon activation of the at least one user input device;

a receiver for receiving a wireless signal including caller identification information received from a telephone system; and

a display for displaying the caller identification information received via the transceiver, wherein the display displays the caller identification information based on a user option configuring the display location of the caller identification information.

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9. EVIDENCE APPENDIX

None

10. RELATED PROCEEDINGS APPENDIX

None